

REMARKS

This request for reconsideration is filed in response to the final Office action, mailed July 11, 2003, in which all of the claims of the application, namely claims 1-7 are rejected.

Rejections under 35 U.S.C. §102:

At paragraph 5 of the Office action, claims 1-2 are rejected under 35 U.S.C. §102(b) as being anticipated by Neeson *et al* (U.S. Pat. No. 5,786,998).

With respect to claim 1, applicant has argued that there is simply no teaching (or suggestion) in Neeson *et al* of comparing installed device components with available device components, and then providing an offer to upgrade installed device components, as in claim 1, the only independent claim of the application, the assertion by the prior Office action that Neeson *et al* shows at col. 19, lines 53-67, a device identifier for comparing installed device components with available device components and for providing an offer to upgrade installed device components notwithstanding. Applicant argued in response to the previous Office action that what is being taught at the cited location is merely a procedure that "functions to accept configuration change messages from [a] front end processor 46 to reconfigure ... configurable items [in what is called the ALERTS application]," i.e. the ALERTS (Automated Locomotive Equipment Reporting and Tracking System) application being what the Office action asserts to be analogous to the device identifier module recited in claim 1.

In response to applicant's argument, the Examiner in the final Office action cites col. 4, lines 22-27, in asserting that Neeson *et al* discloses "a comparison device ... comparing equipment ID information in the temporary information storage device with the equipment ID information in the equipment ID information storage device of a standard or specific locomotive," and cites col. 8, lines 24-42, in asserting that Neeson *et al* discloses that "ALERTS provides updates to customers about the equipments (*sic*) then (*sic*) it is up to the customers to decide whether an (*sic*) upgrade any of the installed equipment based on the information provided." Applicant respectfully submits that what is disclosed at col. 4, lines 22-27, is a comparison of equipment on a locomotive at the time of the most recent health report with equipment on the locomotive at the time of an earlier health report (and so not a comparison of installed and available equipment, as in the claims). And applicant

respectfully submits that what is disclosed at col. 8, lines 24-42, also is not a comparison of installed and available equipment, as in the claims, the language at col. 8, lines 36-38 (“ALERTS ... provides the up-to-date information to railroad personnel on available equipped locomotives 38”) notwithstanding. The phraseology “available equipped locomotives” clearly means locomotives appropriately equipped for communication and so “available” in the sense of accessible via telecommunication so as to be able to transmit health update reports. The phraseology “available equipped locomotives” is never further explained, but the term “available” is used at col. 2, line 33, in connection with a communication system (being “available”) on a locomotive for providing real-time updates of equipment inventory on the locomotive. In confirmation, instead of mentioning anything in connection with available equipment as opposed to installed equipment at the cited location, Neeson *et al* goes on to explain:

The ALERTS portion located in the front end processor 46 provides updates to the dispatcher 32 or customer 34 on equipment additions, replacements, outages and removals. Finally, the ALERTS application in the mobile communications package 12 monitors the on-board intelligent devices and reports initial configuration and configuration changes to the front end processor 46. Each of these portions of the ALERTS will be discussed in detail below.

There is thus simply no teaching or suggestion at the cited location of comparing *installed* with *available* equipment (i.e. possible upgrades), but only comparing presently installed with earlier installed. (Applicant also refers the Examiner to col. 4, line 66, through col. 5, line 15, where Neeson *et al* makes clear that ALERTS is all about what changes *have been made*, not what changes *might be made* based on a comparison of installed and available equipment.) Applicant therefore respectfully insists that Neeson *et al* does not teach or suggest comparing installed device components with available device components, and then providing an offer to upgrade installed device components, as in claim 1.

Accordingly, applicant respectfully requests that the rejection under 35 U.S.C. §102 of claim 1, and also the rejection of claim 2 on the ground that claim 2 depends from claim 1, be reconsidered and withdrawn.

Rejections under 35 USC §103:

At paragraphs 3 and 4 of the Office action, claims 3-7 are rejected under 35 USC 103(a) as being unpatentable over Neeson *et al* in combination with one or more other references.

As stated in the response to the previous Office action, in making the rejections, the Office action apparently relies on Neeson *et al* as applied in the rejections of claim 1 under 35 USC §102, and for the reasons given in the earlier response as well as above, it is believed that Neeson *et al* fails to teach having a device identifier compare installed device components with available device components or provide an offer to upgrade installed device components based on such a comparison, nor can applicant's attorney find in the reference where such a comparison or offer is suggested. Therefore, since claims 3-7 all depend directly or indirectly from claim 1, claims 3-7 are believed allowable over the combinations made in the Office action.

Further, applicant respectfully reasserts that the combinations made in the Office action are improper. To combine references, as set out in the MPEP at 706.02(j), the Examiner must establish a *prima facie* case of obviousness, which requires first, that there be "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," second, that "there must be a reasonable expectation of success," and third, that the combination made in the Office "teach or suggest all the claim limitations." Even assuming, *arguendo*, that somehow Neeson *et al* can be interpreted to teach or suggest the invention as claimed in claim 1 (and applicant certainly does not believe that is possible under a reasonable reading of Neeson *et al*, for the reasons given above), instead of showing "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings," the Examiner asserts simply that by making the combination made in the Office action, "would provide for controlling the components with a programmable controller in order to manage the automation process dynamically

and effectively." Applicant respectfully submits that such a justification makes the requirement for setting out a *prima facie* case purely illusory. In effect, what the Examiner is saying, without any support from the prior art, is that by making the combinations made in the Office action, things would work better. Applicant regards such an assertion not as providing an element of a *prima facie* case of obviousness, but instead a concession that the claimed invention is *useful*, and respectfully reasserts that the combinations made in the Office action are made purely in hindsight and so are improper, and on that ground alone the corresponding rejections ought to be withdrawn.

In addition to the above, applicant renews all of the arguments made in response to the previous Office action not responded to by the Examiner in the present, final Office action.

Further, now in respect to claim 5, which recites as a component of the invention a general technical information database (18) for providing general technical information about products organized by topic, the general technical information database (18) being used for maintaining a record of requests for information made about a topic thereby providing feedback on the useability of products, the final Office action asserts that Ogushi *et al* teaches such a general technical information database (as what is there called a "trouble database"), now citing page 3, paragraphs 46-47, which read:

[0046] The operator on the vendor or factory side can input information such as the model (401) of the industrial equipment, the serial number (402), the case of trouble (403), the date of trouble occurrence (404), the emergency degree (405), the trouble state (406), the countermeasure (407), and progress (408). Note that information may be automatically input to the trouble database by the host computer 108, as described above.

[0047] The browser software of the window shown in FIG. 5 has a hyperlink function (410 to 412) which allows each worker in each department of the vendor and each operator in each factory to access detailed information of each item, retrieve a new version of the software from the software library, or retrieve an operation guide (auxiliary information) as the reference for the operator in the factory.

Applicant respectfully renews applicant's assertion that Ogushi *et al* does not teach or suggest maintaining a *record of requests for information made about a topic*, thereby

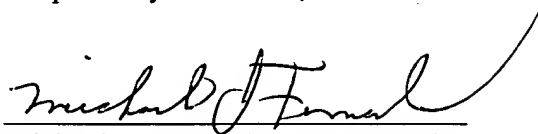
providing feedback on the useability of products, but instead finds only a teaching of *sharing maintenance information* (including "past maintenance information") so as to "improve the maintenance efficiency," as explained at col. 49. The newly cited paragraphs of Ogushi *et al*, prefatory to the already cited and discussed paragraphs 48 and 49, teach only inputting to the trouble database a fix to a problem (and the problem description), and teach enabling users to share such information. As applicant argued in the response to the previous Office action, sharing maintenance information is not at all the same as keeping a record of requests for information about a topic so as to provide information about the useability of products associated with the topics for which the information is requested. Sharing maintenance information helps people determine how to maintain equipment; it does not tell (or suggest to) a manufacturer whether people believe equipment is hard to *use*. There is simply no teaching or suggestion of maintaining a record of requests even for maintenance information on a topic (i.e. keeping track of the *number of requests* on a topic); instead, as mentioned, there is only a teaching of *sharing* maintenance information (in the "trouble database").

For the foregoing reasons, applicant respectfully requests that the rejections under 35 USC §103 of claims 3-7 be reconsidered and withdrawn.

CONCLUSION

For all the foregoing reasons it is believed that claims 1-7, are in condition for allowance and their passage to issue is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Michael J. Femal", written over a horizontal line.

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